

REMARKS

Restriction Requirement

The Examiner noted that the sequences depicted as SEQ ID NO:1-20 co-express with nucleic encoding known matrix proteins having different functions. SEQ ID NO:1-20 differ in structure a well. Therefore, the Examiner stated, the restriction requirement will separate the nucleic acids having SEQ ID NO:1-20. The Examiner further noted that claim 7 is missing and thus the claims have been renumbered in accordance with rule 126.

Therefore, in the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Groups 1-20 (claims 1-3 and 12-14) drawn to polynucleotides having SEQ ID NO:1-20, respectively.

Groups 21-40 (claims 4-8) drawn to a method of identifying ligands to polynucleotides having SEQ ID NO:1-20, respectively.

Groups 41-53 (claims 9-11) drawn to a method for detecting gene expression of polynucleotides having SEQ ID NO:1-20, respectively.

Groups 54-73 (claims 15 and 16) drawn to protein encoded by the polynucleotides having SEQ ID NO:1-20, respectively.

Groups 74-93 (claims 17-19) drawn to a method of using polypeptide encoded by polynucleotides having SEQ ID NO:1-20, respectively.

The Examiner further stated that if any of inventions 21-40 is elected, applicant is requested to also elect a molecule selected from the group of claims 5 and 8. These molecules differ in structure and function and are therefore considered to be patentably distinct. The Examiner also stated that if any of inventions 74-93 is elected, applicant is requested to also elect a molecule selected from the group of claim 18. These molecules differ in structure and function and are therefore considered to be patentably distinct.

Applicants hereby elect, with traverse, to prosecute Group 6, which includes and is drawn to Claims 1-3 and 12-14 and to SEQ ID NO:6 (which encodes SEQ ID NO:22). Applicants object to

the excessive restriction of claims, particularly with respect the restriction of examination to a single species of polynucleotide or polypeptide. The MPEP § 803.04 states that when an application contains both composition of matter and combination claims, as in claims 1 and 2 of Groups 1-20 of the instant application, and as recited in examples A-C in the MPEP § 803.04:

In applications containing all three claims set forth in examples (A)-(C), the Office will require restriction of the application to ten sequences for initial examination purposes. Based upon the finding of allowable sequences, claims limited to the allowable sequences as in example (A), all combinations, such as in examples (B) and (C), containing the allowable sequences and any patentably indistinct sequences will be rejoined and allowed. (Emphasis added)

Thus applicants submit that it would be proper, and not of undue burden, to examine at least ten sequences in claims 1-3 of Groups 1-20. Applicants further submit that since the method of use claims 4-14 are limited in scope to the compositions of claims 1 and 2 from which they depend, these claims could also be examined together with the compositions of claims 1 and 2 without undue burden. Applicants also note that the Examiner's requirement for an election of species among the molecules of claims 5 and 8 relative to the examination of claims 6-8 of Groups 21-40 is unnecessary as the claims are limited to the use of compositions from which they depend and are therefore allowable based on the finding of the compositions themselves as novel and nonobvious. The "patentable distinctiveness" of the molecules to be screened is therefore moot with respect to the examination of these claims.

Applicants therefore request reconsideration of the Restriction Requirement and examination of all of SEQ ID NO:1-10 in claims 1-14. In the event the Examiner maintains the Restriction Requirement, Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

CONCLUSION

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE CORPORATION

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David G. Streeter

David G. Streeter, Ph.D.

Reg. No. 43,168

Direct Dial Telephone: (650) 845-5741

Customer No.: 27904
3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886